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S/N 09/450,768
Petition to Withdraw Finality

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Osamu KUBONIWA

Group Art Unit: 2662

Serial No.: 09/450,768

Examiner: Tsegaye, Saba

Filed: Nov. 30, 1999

Atty. Docket No. MA-385-US

For: ADSL SYSTEM

Honorable Commissioner of Patents
Alexandria, Virginia 22313-1450

PETITION TO WITHDRAW FINALITY OF REJECTION AS PREMATURE
UNDER 37 C.F.R. §1.181

Sir:

Applicant respectfully petitions under 37 C.F.R. §1.181 that the finality of Patent Application S/N 09/450,768: "ADSL SYSTEM" be withdrawn as premature under the guidelines of MPEP §706.07(a). This guideline states: "... second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims ..." (Emphasis by Applicant).

Applicant respectfully submits that, contrary to the Examiner's position in the latest Office Action dated July 14, 2004, one of ordinary skill in the art would readily recognize that the claim amendments in the Amendment Under 37 C.F.R. §1.111, filed on April 23, 2004, were not at all directed to the purpose of overcoming the rejection of the Office Action dated January 23, 2004, based on US Patent 6,141,339 to Kaplan et al. Applicant submits that no claim amendments were necessary to overcome this rejection, since the Examiner's interpretation of Kaplan were clearly technically incorrect.

As clearly pointed out in MPEP §706.07:

"Before final rejection is in order a clear issue should be developed between the

S/N 09/450,768
Petition to Withdraw Finality

examiner and applicant.... The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." (Emphasis Applicant's)

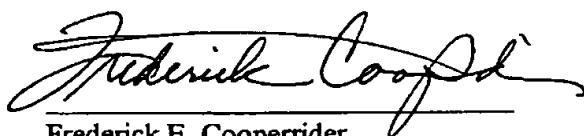
As Applicant pointed out in the Amendment Under 37 C.F.R. §1.111, filed on April 23, 2004, the rejection in the Office Action of January 23, 2004, simply failed to meet the initial burden of a *prima facie* rejection under 35 U.S.C. §102, because the Examiner failed to heed the plain meaning of the claim language and failed to properly interpret the technology in the cited reference.

As pointed out in the Amendment Under 37 C.F.R. §1.116, concurrently filed herewith, Applicant additionally submits that the new rejection presented in the Office Action dated July 14, 2004, likewise fails to meet the initial burden of a *prima facie* rejection under 35 U.S.C. §102, and for the same reasons that the rejection fails to heed the plain meaning of the claim language and properly interpret the technology of the cited reference.

For at least the reasons outlined above, Applicant petitions that the finality of rejection for the above-identified Application be withdrawn.

Respectfully submitted,

Date: 10/14/04



Frederick E. Cooperrider
Reg. No. 36, 769

McGinn & Gibb, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

S/N 09/450,768
Petition to Withdraw Finality

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Petition to Withdraw Finality of Rejection as Premature Under 37 C.F.R. §1.181 by facsimile with the United States Patent and Trademark Office addressed to Examiner Saba Tsegaye, Group Art Unit 2662, at fax number (703) 872-9306 this 14th day of October, 2004.


10/14/04
Frederick E. Cooperrider, Reg. No. 36,769